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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/500,977      | 02/15/2000  | James W. Soong       |                     | 5482             |

7590 03/18/2003

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[REDACTED] EXAMINER

BLECK, CAROLYN M

| ART UNIT | PAPER NUMBER |
|----------|--------------|
|          | 3626         |

DATE MAILED: 03/18/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

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|                              |                                    |                         |
|------------------------------|------------------------------------|-------------------------|
| <b>Office Action Summary</b> | <b>Application No.</b>             | <b>Applicant(s)</b>     |
|                              | 09/500,977                         | SOONG, JAMES W.         |
|                              | <b>Examiner</b><br>Carolyn M Bleck | <b>Art Unit</b><br>3626 |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 15 January 2003.
- 2a) This action is FINAL.      2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 21-40 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 21-40 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. §§ 119 and 120

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) The translation of the foreign language provisional application has been received.
- 15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

#### Attachment(s)

- |  |  |
|--|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                    | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ . |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)           | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ . | 6) <input type="checkbox"/> Other: _____                                     |

**DETAILED ACTION**

***Notice to Applicant***

1. This communication is in response to the amendment filed 15 January 2003. Claims 1-20 have been cancelled. Claims 21-40 are newly added.

***Specification***

2. The amendment filed 15 January 2003 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows:

The newly added recitation of "determining access rules to selectively govern access to the component fields, applying the access rules before the component fields are accessed, providing access to a first predetermined amount of the component fields of the records when a first access parameter is present (emphasis added), and providing access to a second predetermined amount of the component fields of the records when a second access parameter different from the first access parameter is present, the second predetermined amount not identical to the first predetermined amount (emphasis added)" within claims 21, 22, 24, 25, 27, 28, 29, 31, and 32 appears to constitute new matter. Further, the newly added recitation of "a first medical condition of the patient" and "a second predetermined amount relating to a second medical condition" in claim 22, "the first predetermined amount indicative of good health

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of the patient" and "amount indicative of bad health of the patient" in claim 28, "the first predetermined amount satisfying a first criterion about monetary amounts owed by the patient" and "the second predetermined amount satisfying a second criterion about monetary amounts owed by a patient" in claim 29, and "an electronic file history" within claim 39 appears to constitute new matter. In particular, Applicant does not point to, nor was the Examiner able to find any support for access rules, access parameters, and electronic file history within the specification as originally filed. As such, Applicant is respectfully requested to clarify the above issues and to specifically point out support for the newly added limitations in the originally filed specification and claims.

3. Applicant is required to cancel the new matter in the reply to this Office Action.

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. The specification is objected to under 35 U.S.C. 112, first paragraph, because the specification, as originally filed, does not provide support for the invention as is now claimed for the reasons given in section 2 above.

#### ***Claim Rejections - 35 USC § 112***

5. Claims 21, 22, 24, 25, 27, 28, 29, 31, 32, and 39 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that

the inventor(s), at the time the application was filed, had possession of the claimed invention and for the reasons set forth in the objection to the specification above.

Independent claim 21 recites limitations that are new matter, as discussed above.

Claims 22, 24, 25, 27, 28, 29, 31, and 32 incorporate the deficiencies of independent claim 21, through dependency, and dependent claim 39, are also rejected.

***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

**NOTE:** The following rejections assume that the subject matter added in 15 January 2003 amendment are NOT new matter, and are provided hereinbelow for Applicant's consideration, on the condition that Applicant properly traverses that the new matter objections and rejections made in sections 2-5 above in the next communication sent in response to the present Office Action.

7. Claims 21, 23, 30-31, and 38 are rejected under 35 U.S.C. 102(b) as being anticipated by Norden-Paul et al. (4,878,175).

(A) As per claim 21, 23, 30-31, and 38, Norden-Paul discloses a method related to a hospital-based patient record keeping system for customizing a patient medical information form and selectively granting access to a user (col. 1 lines 5-27, col. 16 lines 24-32, and col. 17 lines 30-40) comprising:

- (a) using a plurality of database records each corresponding to parameters, wherein each record comprises a plurality of data fields which contain information about the content and layout of a selected parameter relating to a patient (col. 13 lines 5-10);
- (b) defining access privileges (reads on "access rules") for specific groups of users, such as nurses, physicians, therapists, and lab technicians, wherein privileges may also vary according to a particular section or form comprised of data fields (reads on "component fields"), the particular patient, the particular user, and the particular terminal location, wherein privileges may vary within a given form regarding whether access is read-only or read write, wherein a security editor is used to define conditions for accessing and/or modifying the various sections and forms to generate proper access entitlements (col. 14 lines 20-48);
- (c) logging onto the system using a user I.D. number and password in order to make changes to parameters (i.e., particular sections of a section or form) (reads on "applying the access rules before the component fields are accessed") (col. 14 lines 20-48);
- (d) viewing sections and forms including a plurality of data fields, wherein the forms and sections viewed by one category of user (e.g., nurses) (reads on "first") may differ from those viewed by a different category of user (e.g., physicians, lab

technicians) (reads on "second") (col. 7 lines 10-50 and col. 13 lines 5-10), wherein the sections and forms displayed for each category of user may be a standard (reads on "predetermined") set of sections and forms directed to displaying patient information based on location, such as on a ward for nurse's charting versus a physician office for physician review (col. 7 lines 10-50 and col. 13 lines 5-10); and

(e) customizing patient charts to the individual patient by selecting one a form option, displaying a selected form, and selecting a parameter operation, wherein the user is able to add, modify, and delete parameters within forms by clicking on an ADD, MODIFY, and DELETE parameter icons based on the unique requirements of an individual hospital, hospital unit, and/or individual and whether the parameters are default parameters (col. 10 line 40 to col. 14 line 20 and col. 18 lines 1-28).

#### ***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**NOTE:** The following rejections assume that the subject matter added in 15 January 2003 amendment are NOT new matter, and are provided hereinbelow for Applicant's consideration, on the condition that Applicant properly traverses that the new matter objections and rejections made in sections 2-5 above in the next communication sent in response to the present Office Action.

9. Claims 22, 24-29, 32, and 39-40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Norden-Paul et al. (4,878,175).

(A) As per claims 22 and 24-29, the relevant teachings of Norden-Paul are as discussed in the rejections above, and incorporated herein.

Norden-Paul discloses defining access privileges (reads on "access rules") for specific groups of users, such as nurses, physicians, therapists, and lab technicians, wherein privileges may also vary according to a particular section or form (reads on "component fields"), the particular patient, the particular user, and the particular terminal location, wherein privileges may vary within a given form regarding whether access is read-only or read write, wherein a security editor is used to define conditions for accessing and/or modifying the various sections and forms to generate proper access entitlements (col. 14 lines 20-48). Further Norden-Paul discloses a cardiologist visiting patient in different hospital units viewing patient information in a particular way, concentrating on specialty, whereas a nurse using a bedside terminal in a ward views a different set of sections and forms, and wherein a particular hospital unit may view sections and forms on a patient-specific basis such as a critical care unit patient may require special dietary monitoring or social service monitoring, therefore a customized chart may be viewed based on the patient's needs (Norden-Paul; col. 7 lines 10-46).

Norden-Paul is entirely silent as to allowing a health care provider to view all of the component fields. However, as discussed above, Norden-Paul includes defining

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using access privileges which parts of a form (i.e., component fields) a user is to view. Therefore, it is respectfully submitted that typically in medical records management a health care provider would have complete access to patient records, and the skilled artisan would have found it an obvious modification to include giving a health care provider complete access to all of a patient's record within the method disclosed by Norden-Paul with the motivation of ensuring a physician or other health care provider is able to view records quickly, especially in an emergency, therefore leading to improved health care diagnosis and treatment.

Norden-Paul fails to expressly disclose providing access to predetermined amounts of component fields, wherein the first predetermined amount is indicative of good health of the patient or a second predetermined amount is indicative of bad health of the patient, or wherein the first predetermined amount satisfying a first criterion about monetary amounts owed by the patient and the second predetermined amount satisfying a second criterion about monetary amounts owed by the patient. Norden-Paul is entirely silent as to providing accounting or billing personnel a fraction of all component fields, where the accounting or billing personnel are denied access to health information of the patient. However, Norden-Paul includes as discussed above, viewing sections, forms, and parts of forms based on access privileges. Further, it is respectfully submitted that viewing the health of a patient, either good or bad, or the billing information of a patient is confidential information, which does not require access by all entities of a hospital (col. 1 lines 20-43 and col. 14 lines 22-42), and therefore it would have been an obvious modification to Norden-Paul's method to include displaying

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information based on access privileges for viewing confidential information such as good or bad health of a patient or billing information with the motivation of meeting the diverse requirements of different hospital entities but preserving the confidentiality of patient information by using security privileges (Norden-Paul; col. line 15 to col. 2 line 54 and col. 14 lines 22-42).

Norden-Paul is entirely silent as to allowing a patient to view a fraction of all component fields. However, as discussed above, Norden-Paul includes viewing sections, forms, and parts of forms based on access privileges. Further, it is respectfully submitted that viewing patient medical information is confidential information, which does not require complete access by all entities, including the patient (col. 1 lines 20-43 and col. 14 lines 22-42), and therefore it would have been an obvious modification to Norden-Paul's method to include displaying information based on access privileges for viewing confidential information with the motivation of meeting the diverse requirements of different hospital entities but preserving the confidentiality of patient information by using security privileges (Norden-Paul; col. line 15 to col. 2 line 54 and col. 14 lines 22-42).

(B) As per claim 32, the relevant teachings of Norden-Paul are as discussed in the rejections above, and incorporated herein.

Norden-Paul discloses using a security editor to define conditions for accessing and/or modifying the various sections and forms to generate proper access entitlements to patient information (col. 14 lines 20-48). Although Norden-Paul is entirely silent as to

allowing the patient to define access rules, it is respectfully submitted that allowing the patient to use Norden-Paul's security editor would be an obvious modification to the Norden-Paul method with the motivation of allowing a patient to manage their confidential information thus increasing a patient's satisfaction with the health care system.

(C) As per claims 39 and 40, the relevant teachings of Norden-Paul are as discussed in the rejections above, and incorporated herein.

Norden-Paul includes using a plurality of database records each corresponding to parameters, wherein each record comprises a plurality of data fields which contain information about the content and layout of a selected parameter relating to a patient (col. 13 lines 5-10). It is noted that Norden-Paul's database is a form of an electronic file history. Norden-Paul fails to expressly disclose a selectable parameter including billing data. However, Norden-Paul includes entities such as accounting using record-keeping systems (col. 1 lines 28-36). It is respectfully submitted that billing information is typically stored in a hospital data processing system (col. 1 lines 20-36), and the skilled artisan would have found it an obvious modification to include billing data within the method of Norden-Paul with the motivation of meeting the diverse requirements for information of hospital entities (Norden-Paul; col. 1 line 65 to col. 2 line 8).

10. Claims 33-34 and 37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Surwit et al. (6,024,699).

(A) As per claim 33-34, Surwit discloses a method for a medical data processing system (col. 1 lines 5-11) comprising:

- (a) providing a server connected to one or devices or monitors, wherein the server includes database for storing and manipulating patient data (col. 9 lines 24-48);
- (b) identifying emergency medical conditions within the server based on physiological or behavioral data collected (reads on "physiological and non-physiological data") (col. 12 line 15 to col. 16 line 57 and col. 17 lines 1-15);
- (c) analyzing data transmitted from a patient monitoring system substantially simultaneously with the transmission thereof to the server to identify emergency medical conditions requiring immediate medical attention (col. 23 lines 20-25); and
- (d) automatically communicating treatment information to the respective patient monitoring system for the patient for an identified emergency medical condition (col. 23 lines 25-30).

It is respectfully submitted that Surwit's "identifying emergency medical conditions within the server based on physiological or behavioral data collected" (col. 12 line 15 to col. 16 line 57 and col. 17 lines 1-15) is considered to be a form of a threshold event as the patient's medical condition is above a certain level. It would be an obvious modification to include using a specific threshold event within the method of Surwit with the motivation of immediately notifying medical personnel of an emergency (Surwit; col. 2 lines 55-63).

(B) As per claim 37, Surwit discloses the emergency medical condition relating to collected behavioral or physiological data, automatically communicating treatment information to the respective patient monitoring system of a child patient for an identified emergency medical condition, and communicating messages to the patient to schedule an office visit with a physician or to alter transmission schedules (col. 8 lines 18-35, col. 17 lines 1-15, col. 18 line 45 to col. 19 line 12, and col. 23 lines 25-30).

11. Claim 35-36 rejected under 35 U.S.C. 103(a) as being unpatentable over Surwit et al. (6,024,699) as applied to claim 33 above, and further in view of Campbell et al. (6,208,974).

(A) As per claims 35-36, Surwit includes means for automatically communicating information to the respective patient monitoring system for the patient for a identified condition (col. 23 lines 25-30). However, Surwit fails to expressly disclose a threshold event relates to monetary amounts owed by the patient to a health care provider, wherein the electronic notification includes a request to make payments to the health care provider after services are performed. Campbell discloses a billing function within software on a central computer over a computer network for managing patient visits and keeping patient records, wherein the central computer indicates when a patient's account is overdue (col. 2 lines 5-20). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to include the components of Campbell within the method of Surwit with the motivation of to receive appropriate

compensation for services rendered by the health care provider (Campbell; col. 1 lines 19-31).

***Response to Arguments***

12. Applicant's arguments with respect to claims 21-40 have been considered but are moot in view of the new ground(s) of rejection.

***Conclusion***

13. The prior art made of record and not relied upon is considered pertinent to the Applicant's disclosure. The cited but not applied prior art teaches a method of managing and controlling access to personal information (6,073,106).

14. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Carolyn Bleck whose telephone number is (703) 305-3981. The Examiner can normally be reached on Monday-Thursday, 8:00am – 5:30pm, and from 8:30am – 5:00pm on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas can be reached at (703) 305-9588.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Receptionist whose telephone number is (703) 306-1113.

**16. Any response to this action should be mailed to:**

Commissioner of Patents and Trademarks  
Washington, D.C. 20231

**Or faxed to:**

- |                |  |
|----------------|--|
| (703) 305-7687 | [Official communications; including After Final communications labeled "Box AF"] |
| (703) 746-8374 | [Informal/ Draft communications, labeled "PROPOSED" or "DRAFT"]                  |

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Hand-delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive,  
Arlington, VA, 7th Floor (Receptionist).

CB

CB

March 12, 2003

  
DINH X. NGUYEN  
PRIMARY EXAMINER